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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/534,861

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Hans Brannstrom

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EXAMINER

SELF, SHELLEY M

ART UNIT

PAPER NUMBER

3725

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/534,861	<b>Applicant(s)</b> BRANNSTROM ET AL.	
	<b>Examiner</b> Shelley Self	<b>Art Unit</b> 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/12/05; 10/31/05; 7/30/07</u> .                              | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 3725

## **DETAILED ACTION**

### ***Claim Objections***

Claim 13 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim fails to further limit the parent claim 1, and instead changes/alters the scope to include a flooring comprising a plurality of floorboards of claim 1. Examiner suggests claim 13 be re-written in independent form encompassing all of the structure/limitations of the parent claim 1.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner notes claim 1 states, "A floorboard for making..." it is unclear if the claim is claiming a method of making or the floorboard, i.e. product. Clarification is required. Examiner suggests use of a transitional phrase, i.e., comprising, consisting of... For the purposes of examination, Claims 1-12 are understood to be product-by-process claims.

Further regarding claim 1, it is unclear how the floorboard is made by, "...joining at least one neighboring identical floorboard", if the floorboard is the nearing boards joined together. Is

Art Unit: 3725

the floorboard comprised of boards joined together? Accordingly a clear understanding of the claims can not be determined.

With regard to claim 2, the recitation, "it" renders the claim indefinite, as it can not be determined what "it" refers to, Examiner suggests clear and positive recitation of the structure to which "it" refers.

With regard to claims 6 and 7, there is no antecedent basis for the recitation, "the horizontal extent". Clarification is required. For the purposes of examination, Examiner understands claim 6 to depend from claim 5.

With regard to claim 11, neither the long sides nor the short side have been positively recited, therefore there is insufficient antecedent basis for the recitations, "the long sides" and "the short sides". Clarification is required.

The above listing of 35 U.S.C. 112 2<sup>nd</sup> paragraph rejections is not conclusive. Applicant is required to review all of the claims for clarity, definiteness and clear concise antecedent basis.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 14-17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Moriau et al. (6,006,486). Moriau substantially discloses the claimed invention. Moriau teaches a flooring comprised of neighboring substantially identical floorboards, joined by upper part

Art Unit: 3725

(figs. 9-11), a joint plane( B; fig. 9), a resilient base (58) a supporting layer (8) a locking/fastening system (6, 9, 10; figs. 9-11; col. 5, lines 50-53).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-12, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moriau et al. (6,006,486) alone, as noted above, claims 1-12 are understood to be product-by-process claims. Therefore the process steps, i.e. constructed wherein the resilient bases...extends at last partly under the neighboring floorboard is not germane to the patentability of the finished product. Examiner further notes the finished product, i.e. a flooring does not patently define any distinguishing structure over that of the prior art.

As to the use or selection of elastic, rubber, MDF, HDF, plywood, particleboard, wood material plastic material or metal (clms. 2-7, 9-12) Examiner notes the selection of any known material based on its suitability for the intended use is a matter of obvious design expedients and requires only routine skill in the art. Furthermore such selection would be obvious to the skilled Artisan as Applicant has failed to positively recite any criticality to the use of elastic, rubber, MDF, HDF, plywood, particleboard, wood material plastic material or metal and instead teaches functionality with the use of each known material. Therefore such selection is not non-obvious and does not in itself warrant patentability. See *In re Leshin*, 125 USPQ 416.

Art Unit: 3725

As to the recitation, supporting layer having a greater modulus of elasticity (MOE) than the resilient base (clm. 8); Examiner notes that difference of materials utilized for the resilient base and the supporting layer will inherently result in differing modulus of elasticity values as such is a defined characteristic of all materials. As to the MOE of the resilient layer being greater than that of the supporting layer selecting or determining an optimum value of either the resilient base MOE or the supporting layer MOE involves only routine skill in the art. See *In re Boesch*, 617 F.2d 272, 205 USPQ

As to the resilient base having a first horizontal extent substantially equal to a length of a first edge and a second horizontal extent less than half a length of a second edge of the floorboard (clm. 18), it would have been obvious at the time of the invention to construct Moriau such that first horizontal extend substantially equal to a length of a first edge and a second horizontal extend less than half a length of a second edge of the floorboard, because it has been held that discovering an optimum valve of a result effective variable, i.e. the lengths of the extent involves only routine skill in the art. . See *In re Boesch*, 617 F.2d 272, 205 USPQ

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is 571-272-4524. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3725

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shelley Self/  
Primary Examiner, Art Unit 3725

SS  
September 26, 2008